

REMARKS

By this Amendment, claims 4, 5, 8, 9, 10, 12, 15, 16, 19, 21, 27 and 28 have been amended to merely clarify the recited subject matter without any intention of narrowing the scope of any of the claims. Further, new claims 29-33 have been added. Applicants have amended the currently pending claims in order to expedite prosecution and do not, by this amendment, intend to abandon subject matter of the claims as originally filed or later presented. Moreover, Applicants reserve the right to pursue such subject matter in a continuing application. Claims 1-33 are pending in this patent application. Reconsideration of the rejections in view of the remarks below is requested.

The Examiner asserted that applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. In response, Applicants have amended page 1 of the application to clarify the reference to the applications to which Applicants claim benefit and/or priority. Applicants respectfully point out that the cross-reference section, at the time the application was filed, did specify the relationship of this application to the applications upon which reliance is made for priority. Therefore, Applicants respectfully submit that the amendment presented herein does not present new matter but, instead merely changes the format of the language concerning the "Related Applications."

Applicants note that this application was filed before November 29, 2000 and so 37 C.F.R. §§1.78(a)(2)(ii) and 5(ii) are not applicable. Applicants also respectfully point out that the priority claims were detailed in the specification at the time the application was filed. Moreover, the cover sheets to the application list the priority information.

The Examiner objected to claim 20. According to the Examiner, claim 20 contained a spelling error. In particular, the Examiner stated that, in line 1, "farther" should be changed to --further --. Applicants respectfully submit that the word "farther" does not appear in Applicants copy of claim 20. Applicants' copy of claim 20, line 1 recites "further" rather than "farther" as identified in the Office Action. If the Examiner's copy of claim 20 does indeed recite "farther", applicants kindly request the Examiner to contact the undersigned to resolve this discrepancy.

The Examiner rejected claims 5, 8-11, 16, 19, 21, 22 and 24 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner stated that each of these claims contain the phrases "can be" or "may be" and that the inclusion of

these phrases renders the claims indefinite. While Applicants do not agree with the rejection, Applicants also do not believe that alteration of the claims in the manner suggested by the Examiner will present a narrowing amendment that might subject the claims to a limited interpretation under the doctrine of equivalents.

Applicants respectfully submit that claims 11, 12, and 24 do not contain either the phrase “can be” or the phrase “may be.” Accordingly, Applicants respectfully submit that the rejection of these three claims under 35 U.S.C. §112 appears to have been made in error.

Applicants have amended claims 5, 8, 9, 10, 16, 19, and 21 to delete certain portions objected to by the Examiner and hence broaden the claims. New claims 29-33 roughly correspond to certain portions deleted from claims 5, 10, 16, and 21. In addition, claim 9 has been amended merely to clarify that the warranty being offered to a relying party is conditioned to be rolled back. With respect to claim 11, Applicants note that claim 10 has been amended to remove the objected to portion. Similarly, with respect to claim 22, Applicants note that claim 21 has been amended to remove the objected to portion. Accordingly, the rejection of claims 5, 8-11, 16, 19, 21, 22 and 24 under 35 U.S.C. §112 having been addressed, Applicants respectfully submit that the rejection be withdrawn.

The Examiner also rejected claims 1-8, 10-19 and 21-28 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,903,882 (“Asay et al.”). Applicants respectfully traverse the rejection, without prejudice, because the teachings of Asay et al. fail to disclose all the features recited by the claims.

Asay et al. disclose a method of managing reliance in an electronic transaction system that includes a certification authority issuing a primary certificate to a subscriber and forwarding, to a reliance server, information about the issued primary certificate. The reliance server maintains the forwarded information about the issued primary certificate. The subscriber forms a transaction and then provides the transaction to a relying party. The transaction includes the primary certificate or a reference thereto. The relying party sends to the reliance server a request for assurance based on the transaction received from the subscriber. The reliance server determines whether to provide the requested assurance based on the information about the issued primary certificate and on the requested assurance. Based on this determination, the reliance server issues to the relying party a secondary certificate providing the assurance to the relying party. (See, Asay et al., in the abstract.)

The Examiner asserted that Asay et al. disclose all the features of claims 1-8, 10-19 and 21-28. However, Applicants’ respectfully submit that Asay et al. fail to at least disclose an electronic transaction system comprising, *inter alia*, a “reliance server issuing electronic

signals representing a signed warranty offer to a relying party” as recited in independent claim 1 and its dependent claims 2-11, 29 and 30 or a method of managing reliance comprising “the relying party bank issuing a signed warranty offer to the relying party” as recited in independent claim 12 and its dependent claims 13-28 and 31-33. In other words, Asay et al. fail to disclose a reliance server making an offer of the warranty to the relying party (which the relying party may accept) instead of simply issuing the warranty to the relying party. An advantage of an offer, among others, is that a relying party could know at the time of the offer the fee it may have to pay for the warranty and then decide whether to accept the offer of the warranty. (See, e.g., page 16, line 15 to page 18, line 4 of the specification.)

Therefore, for at least the above reasons, Asay et al. fail to disclose all the features recited by claims 1-33. Accordingly, Asay et al. cannot anticipate the claims. As a result, Applicants respectfully submit that the rejection under 35 U.S.C. §102(e) should be withdrawn and the claims allowed.

The Examiner also rejected claims 9 and 20 under 35 U.S.C. §103(a) as being obvious in view of Asay et al. Applicants respectfully traverse the rejection under 35 U.S.C. §103(c). Applicants note that the above-referenced application was filed after November 29, 1999, the effective date of 35 U.S.C. §103(c), and that U.S. Patent No. 5,903,882 to Asay et al. is cited herein under 35 U.S.C. §102(e). Per MPEP §706.02(I), the above-referenced application and U.S. Patent No. 5,903,882 were, at the time the invention was made, owned by, or subject to an obligation of assignment, to the same person, Certco, Inc. Therefore, for at least the above reason, Asay et al. is unavailable as prior art under 35 U.S.C. §103(a) against claims 1-33. Thus, Applicants traverse the rejection of claims 9 and 20 and respectfully submit that claims 1-33 are allowable.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance. If questions relating to patentability remain, the examiner is invited to contact the undersigned to discuss them.

CLAXTON ET AL. -- 09/492,459
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Should any fees be due, please charge them to our deposit account no. 03-3975, under our order no. 061047/0265648. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced deposit account.

Respectfully submitted,
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